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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,311	11/12/2003	Ken Rosenblum	1326.007US1	9674

21186 7590 03/28/2006

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/706,311	ROSENBLUM, KEN	
	Examiner	Art Unit	
	Jeffrey A. Shapiro	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9, 10-17, 19-24, 28, 29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265) and further in view of Ahlin et al (US 6,219,587 B1).

Williams discloses a semi-automated pharmacy for filling prescriptions for customers with a will call area (380) (see col. 10, lines 48-53) in which finished prescriptions are kept for customers. Williams further discloses a computer (104) for inputting customer data and prescription data.

Williams does not expressly disclose, but Schlamp discloses a dispenser placed in a wall, for holding items such as filled prescriptions, for customers with access to a particular bin by the customers on one side of the wall and access to a particular bin by the pharmacist to load a customer's prescription on the other side of the wall.

Both Williams and Schlamp are considered analogous art because they both concern article handling, and in particular, Williams concerns filling and storing prescriptions for customers while Schlamp discloses holding finished items for customers. See Schlamp, figures 1 and 2 and col. 1, line 55-col. 2 line 46 and col. 6, lines 29-60.

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At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Schlamp's "will call" device to Williams pharmacy, said device allowing the loading of finished prescriptions into a merchant side of the system and allowing customer pickup of the finished prescription on the other side of the "will call" device, the "will call" device located in a wall between the secure pharmacy prescription filling area and an unsecure customer pickup area on the other side of a wall.

As suggested by Schlamp, one ordinarily skilled would have been motivated to use Schlamp's device in Williams' pharmacy to reduce storage area, reduce the distance required by the pharmacist to reach system, to secure the filled prescriptions while allowing access by customers to their prescriptions after hours, and to provide for cooling/refrigeration of the unit. See Schlamp, col. 2, lines 4-44.

Regarding Claim 4, note that Williams discloses using bar code scanning systems for prescription tracking purposes. See, for example, Williams abstract. At the time of the invention it would have further been obvious to include a scanning system for both the merchant and customer sides of Schlamp's dispenser as it would have been logical to include such a dispenser in Williams' tracking system.

Regarding Claim 11, note that Schlamp's dispenser can be construed to be "adapted" to not dispense all prescription containers of a customer until they have been received because it is computer controlled and readily adaptable by software code to perform such a function.

Regarding Claim 12, similarly, note that Schlamp's dispenser can be construed to be "adapted" to not dispense all prescription containers of a customer until they have been received and to "clear the pickup area" if the customer leaves items in said area.

3. Claims 7, 8, 18, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265) and further in view of Ahlin et al (US 6,219,587 B1).

Williams discloses the system described above. Williams does not expressly disclose, but Ahlin discloses using video conferencing to precipitate customer-pharmacist interaction. See Ahlin, col. 25, lines 33-43.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated video conferencing into Schlamp's dispensing device.

The suggestion/motivation would have been to allow for "pharmacist's review prior to the issuance of a new prescription" per federal or state requirements. See Ahlin, col. 25, lines 33-43.

Note also that telephone conferencing is considered a functional equivalent of video conferencing and are therefore substitutable for each other.

4. Claims 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265) and further in view of Wallace et al (US 6,564,121 B1). Williams discloses the system described above.

Williams does not expressly disclose, but Wallace discloses using credit cards and the like in a medical dispenser. See Wallace at col. 3, lines 11-20.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a user-based payment system in a medical dispenser used in Williams' system.

The suggestion/motivation would have been to allow customers to pay for prescriptions through standard well-known means that do not require excess personnel. See again, col. 3, lines 11-20.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-15 of U.S. Patent No. 6,892,941 B2.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they both describe a medication dispenser assessable by a pharmacist in a pharmacy from one side and by a customer on the other.

7. Claims 1-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-16 of copending Application No. 10/784,507. Although the conflicting claims are not identical, they are not patentably distinct from each other because because they both describe a medication dispenser assessable by a pharmacist in a pharmacy from one side and by a customer on the other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bain (US 2005/0021175 A1) is cited as another example of a medication dispenser assessable by a pharmacist in a pharmacy from one side and by a customer on the other.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571)272-6911. The fax phone

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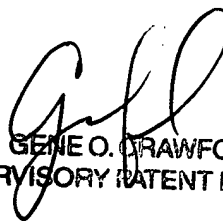
number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro
Examiner
Art Unit 3653

March 19, 2006



GENE O. CRAWFORD
SUPERVISORY PATENT EXAMINER